

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JEFFREY W. SPENCER

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Appeal No. 1999-2182  
Application No. 08/710,704

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ON BRIEF

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Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-16, which are all of the claims pending in this application.

We REVERSE.

### BACKGROUND

The appellant's invention relates to a dispensing system. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Grothoff	4,750,532	Jun. 14, 1988
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ENGLASS Dispensing & Packaging Systems brochure, ENGLASS HVDS dispensers, Jan. 4, 1993 (ENGLASS)

Claims 1-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over ENGLASS in view of Grothoff.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 18) and the final rejection (Paper No. 8) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 15) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

All of the claims stand rejected under 35 U.S.C. § 103. The guidance provided by our reviewing court for considering rejections under Section 103 is as follows: The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988).

The appellant's invention is directed generally to dispensers for viscous products and in particular to overcoming the problem in such dispensers of eliminating unreliable dosing and difficulty in clearing the last part of the product from the dispenser. As manifested in claim 1, the dispenser is described as having a closed, continuous base

formed of one piece and having a dispenser pump mounted at the top. The dispenser further comprises a feed tube extending from the pump down to the container base and having a foot adjacent to the container base, with the foot and the container base

comprising respective interlock portions presenting respective laterally-directed surfaces which overlap axially in a close-fitting interlock engagement to inhibit sideways movement of the feed tube in the container.

The examiner's theory is that ENGLASS discloses all of the claimed subject matter except for the laterally-directed surfaces, but that this is taught by Grothoff and it would have been obvious to one of ordinary skill in the art to replace the dome-shaped dimple of ENGLASS with the laterally-directed surfaces of Grothoff, thus meeting the terms of the claim. The appellant provides several arguments in rebuttal, criticizing the examiner's interpretation of the showings in the references, and opining that there would have been no suggestion to combine the references in the manner proposed by the examiner.

ENGLASS is merely a catalogue that illustrates several types of dispensing containers in cross-section. The examiner refers to one labeled "HYBRID," which has a continuous base formed in one piece with the side wall and comprises an inwardly facing dimple in the center of the bottom which, in the examiner's view, interlocks with the bottom of the pump tube. There is no explicit teaching in this reference of the purpose of the dimple, that it solves any particular problem, or that, in fact, it engages the lower end of the pump tube at all, much less that it inhibits its sideways movement. From our perspective,

the very limited showing of the dispenser in ENGLASS does not support the examiner's conclusion that the dimple inhibits sideways movement of the pump tube. We also note with interest the appellant's explanation in his declaration that inward-oriented dimples are formed into this type of container to insure that an outward-oriented dimple does not form during the manufacturing process, which would adversely affect the ability of the container to sit on flat surfaces, among other reasons, none of which are to restrain the sideways movement of the pump tube.

Grothoff discloses a pump dispenser that includes an arrangement for refilling it. The examiner has looked to Figure 12, which illustrates an embodiment of the invention in which the bottom of the pump tube is disposed about an upstanding projection (608) that would appear from the drawing to restrain its sideways movement, although that is not explicitly stated. While the bottom of the pump tube and this upstanding projection have laterally-directed surfaces that overlap one another, the projection is described as being "connected to" the upper surface of the bottom of the container (column 9, lines 35-37), and therefore it is not part of a closed, continuous base formed in one piece with the sidewall of the container, as is required by claim 1. The purpose of this construction is to provide a refill port in the bottom of the dispenser from which both the pump tube and the container can be refilled through a valved passage in the center of the projection.

It is axiomatic that the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, it cannot be stated with certainty that the inward dimple in the primary reference even inherently inhibits the pump tube from sideways movement. This being the case, while it might have been obvious to install the refilling mechanism of Grothoff in the ENGLASS dispenser, which would eliminate the closed, continuous base required by the claim, we fail to perceive any teaching, suggestion or incentive in either reference that would have led one of ordinary skill in the art to substitute laterally-directed surfaces for the inwardly-oriented dimple, other than the hindsight afforded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The combined teachings of the two applied references thus fail to establish a prima facie case of obviousness with regard to the subject matter of independent claim 1, and we will not sustain the rejection of claim 1 or, it follows, of claims 2-8, which depend therefrom.

Independent claims 9 and 14 set forth the invention in somewhat different terms, but also contain the limitations discussed above. For the same reasons as were set forth with regard to claim 1, the rejection of claims 9 and 14, and dependent claims 10-13, 15 and

16 also is not sustained. In addition, with regard to claim 14, the examiner has provided no evidence in support of his conclusion that the fins recited in claim 14 would have been an obvious matter of design choice.

CONCLUSION

To summarize, the rejection is not sustained, and the decision of the examiner is REVERSED.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPLICATION NO. 08/710,704

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APJ ABRAMS

APJ CALVERT

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DECISION: **REVERSED**

Prepared By:

**DRAFT TYPED:** 16 Jan 02

**FINAL TYPED:**